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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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100-100000-000000-000000

100-100000-000000-000000

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H1022-11-10

EXAMINER

ART UNIT	PAPER NUMBER
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1655
DATE MAILED: 01/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/973,381

Applicant(s)

Hebert

Examiner

Ardin Marschel

Group Art Unit

1655



X Responsive to communication(s) filed on Sep 2, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

X Claim(s) 1-26 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

Claim(s) _____ is/are allowed

X Claim(s) 1-26 is/are rejected.

Claim(s) _____ is/are objected to.

X Claims 1-26 are subject to restriction or election requirement

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

X Information Disclosure Statement(s), PTO-1449, Paper No(s). 12 sheets

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1655.

Applicant's election with traverse of specie VI of claim 1, for example, in Paper No. 6, filed 9/2/99, is acknowledged. The traversal is on the ground(s) that the various oligomers within the scope of the instant claims may contain arbitrarily different monomers from the claims. This is not found persuasive because it does not argue the basis for the specie election that being distinctness of the monomers given in the claims due to very different synthetic methods required for each.

The requirement is still deemed proper and is therefore made FINAL.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2). See, for example, the sequences in the specification on page 89, lines 13 and 25, and elsewhere. However, this application fails to comply with the requirements of 37 CFR § 1.821 through 1.825 because no submission of computer readable form sequences etc. has been submitted. Applicants are given the same response time regarding this failure to comply as that set forth to respond to this office action.

Claims 1-26 are rejected under 35 U.S.C. 112, first

paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention. In order to utilize the oligomers of structure VI they must be synthesized with at least some nucleobases therein for binding to nucleic acids for the hybridization use as instantly described. A thorough review of the instant specification including the numerous examples therein has failed to reveal any synthetic guidance for monomers of structure VI. Nucleotide monomer synthesis is well known in the art to proceed with detailed and complex protection and deprotection steps and are not enabled without at least one detailed description of how this this performed.

No claim is allowed.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

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Art Unit: 1688

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

December 29, 1999

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER